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| APPLICATION NO.                        | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/699,080                             | 10/31/2003  | Barbara Isenberg     | 03727-P0048C        | 1847             |
| 24126                                  | 7590        | 01/31/2005           | EXAMINER            |                  |
| ST. ONGE STEWARD JOHNSTON & REENS, LLC |             |                      | MILLER, BENA B      |                  |
| 986 BEDFORD STREET                     |             |                      |                     |                  |
| STAMFORD, CT 06905-5619                |             |                      | ART UNIT            | PAPER NUMBER     |
|  |             |                      | 3714                |                  |

DATE MAILED: 01/31/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/699,080

**Applicant(s)**

ISENBERG, BARBARA

**Examiner**

Bena Miller

**Art Unit**

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-16 and 18-23 is/are rejected.
- 7) ☒ Claim(s) 17 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_.

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 14 and 21 are finally rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claim 14, there is lack of antecedent basis for the "each of said at least one foot".

Regarding claim 21, there is lack of antecedent basis for the limitation "said manipulator".

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1, 8, 12, 13, 15, 16 and 23 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Hay et al.

Regarding claims 1 and 8, Hay teaches in the figures a toy comprising a figure having a hole passing through a portion thereof (the examiner takes the position that the hole in the support 9 and 10 of the piece 3 does pass through a portion of 9) and at least one ferrous portion embedded completely inside the figure (Hays teaches that

Art Unit: 3714

magnet 8 is located in or below the support and the examiner takes the position that Hays encompasses the required feature), a manipulator having a magnet (13) and a stage (2). It should be noted that a recitation with respect to the manner in which a claimed apparatus intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations.

Regarding claim 12, Hay further teaches the at least one ferrous portion within at least one foot of the figure (fig.6).

Regarding claim 13, Hay further teaches the toy further at least one accessory (the attire worn by piece 3, ice-hockey player; note: fig. 3 and col. 3, par. 2).

Regarding claim 15, Hay further teaches a multiplicity of accessories (15, 16).

Regarding claim 16, Hay further teaches the figure having a hole in a portion thereof (the hole in the support 9 or 10 of the piece 3).

Regarding claim 23, Hay further teaches the manipulator interacts with the at least one ferrous portion (col. 2, lines 18-21).

Claims 8, 13, 19 and 20 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Philippi.

Regarding claim 8, Philippi teaches in figures 1 and 8, a toy comprising a figure (31) having at least one ferrous portion (col. 2, par. 7) embedded completely inside the figure (fig. 8), a manipulator (21) having a magnet (20) and a stage (the combination of 10, 22, 26 and 23)

Regarding claim 13, Philippi further teaches at least one accessory (15).

Art Unit: 3714

Regarding claims 19 and 20, the examiner considers the stage of Philippi as set forth above meets the limitation of a box and the examiner takes the position that the stage box of Philippi is capable of storing the figure, manipulator and the at least one accessory.

Claims 8, 18 and 23 are finally rejected under 35 U.S.C. 102(b) as being anticipated by Goldfarb or Knowles.

Goldfarb and Knowles teaches in the figures a toy comprising a figure (40 and 20, respectively) having at least one ferrous portion embedded completely inside the figure (44; It should be noted that Goldfarb teaches in col. 3, lines 39 and 40 that a plastic disc 42 is mounted to the base of doll and the examiner takes the position that the disc is apart of figure 40; Knowles teaches that each figure 20 is provided with a socket 21 [ col. 3, par. 2] and magnet 25 is received in socket 21 [col. 3, par. 3]), a manipulator (46 and 30, respectively) having a magnet (56 and 31 respectively), and a stage (12 and 10, respectively). It should be noted that a recitation with respect to the manner in which a claimed apparatus intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations.

Regarding claim 18, Goldfarb and Knowles further teaches the stage having an animation surface on one side (col. 2, lines 50-52 and fig. 1, respectively) and a bottom surface (fig. 1 and fig. 2, respectively).

Art Unit: 3714

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2, 4 and 21 are finally rejected under 35 U.S.C. 103(a) as being unpatentable over Parson in view of Woolington.

Parson teaches in the figures most of the elements of the claimed invention including a manipulator (the examiner considers the metals [col. 2, lines 4-7] that are attracted to the magnet of Parson the manipulator). However, Parson fails to teach a plush figure. Woolington teaches a plush doll that is capable of talking and moving its head in to response to an external sound. It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the figure of Parson plush as taught by Woolington for the purpose of providing a soft material toy to prevent possible injuries to a child when playing. It should be noted that a recitation with respect to the manner in which a claimed apparatus intended to be employed does not differentiate the claimed apparatus from the prior art apparatus satisfying the claimed structural limitations.

Claims 2, 3 and 5-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Unalp et al in view of Ware (3,888,233).

Regarding claims 2 and 5, Unalp teaches most of the elements of the claimed invention except for a plush teddy bear figure. Ware teaches in the figures a figure toy

Art Unit: 3714

in the form of a plush teddy bear (col. 2, line 2). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the figure of Unalp plush as taught by Ware for the purpose of providing a soft material toy to prevent possible injuries to a child when playing.

Claim 9 is finally rejected under 35 U.S.C. 103(a) as being unpatentable over Goldfarb in view of Kane.

Goldfarb teaches in the figures most of the elements of the claimed invention except for a bendable and poseable figure. Kane et al teaches in the figures a poseable toy figure that is formed of a wire armature (p. 6, par. 5 and 7). It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide a bendable and poseable as taught by Kane et al for the figure of Goldfarb for the purpose of articulating the figure in different positions.

Claims 10 and 11 is rejected under 35 U.S.C. 103(a) as being unpatentable over Goldfarb in view of Blaustein et al.

Goldfarb teaches in the figures most of the elements of the claimed invention except for a cat plush figure. Blaustein teaches a plush toy in a form of cat (col. 2, par. 1). It would have been obvious to one having ordinary skill in the art at the time the invention was made to make the figure of Goldfarb plush as taught by Blaustein for the purpose of providing a soft material toy to prevent possible injuries to a child when playing. Further, it would be considered a mere design choice to have the plush figure to be a cat.

Claim 14 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hay.

Art Unit: 3714

Hay teaches in the figures most of the claimed elements except for the shoes being removably attached to each foot. It would have been obvious to one having ordinary skill in the art at the time the invention was made have the shoes removably attached to each foot, since it has been held that constructing a formerly integral structure in various elements involves only routine skill in the art. *Nerwin v. Elicman*, 168 USPQ 177, 179.

### ***Response to Arguments***

Applicant's arguments filed 08/23/04 have been fully considered but they are not persuasive. In reference to applicant's response Hays fails to teach or suggest a hole passing through a portion of the figure, the examiner disagrees. The examiner takes the position that the hole in support 9 of Hay does pass through a portion of the figure as seen in figure 6. The applicant argues that hole of the claimed invention passes completely through; however, the claim does not require such.

In reference to applicant's response, Hays fails to teach or suggest the at least one ferrous portion is not embedded inside the figure, the examiner disagrees. It should be noted applicant points out that Hay teach in col. 3, lines 15-18 the magnet is located below or in support 9. Though Hay does not disclose explicitly the magnet "embedded completely inside", the examiner contends Hays citation of the magnet located in the support is encompassed by the claimed element.

In reference to applicant's response that Hay does not teach shoes removable attached to each foot. The applicant once again points out that Hay teaches the magnet is located below or in the support. The examiner takes the position that the



Art Unit: 3714

magnet is in the shoe and such would not prevent one ordinary skill in the art to removably attach the shoe to the foot of the piece of Hay.

Regarding applicant's response that Goldfarb fails to teach the at least one ferrous portion embedded completely inside the figure, the applicant's attention is directed to the above rejection.

In reference to applicant's response that Goldfarb in view Kane, specifically Kane not teach the defects in the teachings of Goldfarb. Kane teaches a bendable and poseable element that have magnet attached to a shoe. Therefore, the examiner takes the position to combine Goldfarb and Kane to meet the claimed elements. In reference to claims 10 and 11, the applicant's attention is directed to the above rejection.

In reference to applicant's response that Parson and Woolington does not teach the claimed elements, the examiner disagrees. Parson teaches a hole passing through a portion of the figure (the Examiner takes the position the hole that is formed for the insertion of the magnet is passing through a portion of the figure's hand as seen in the figure) and a magnet is embedded in the material of the doll as seen in col. 2, line 2. Woolington teaches a toy, which is in same filed of endeavor of the claimed invention, that is plush. Therefore, Parson in combination Woolington would meet the claimed limitations.

In reference to claims 2, 3, 5-7, applicant's attention is directed to the above rejection.

Art Unit: 3714

***Allowable Subject Matter***

Claim 17 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bena Miller whose telephone number is 571.272.4427. The examiner can normally be reached on Monday-Friday.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Bena Miller  
Examiner  
Art Unit 3712

bbm  
January 28, 2005